

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : DASGUPTA, Aninda
Serial No. : 09/691,334
Filed : October 18, 2000
For : SYSTEM AND METHOD FOR DISPLAYING INFORMATION ON THE SCREEN OF A USER INTERFACE DEVICE UNDER THE CONTROL OF A DIGITAL AUDIO PLAYBACK DEVICE
Group Art Unit : 2194
Examiner : TRUONG, LeChi
Confirmation : 5217

BRIEF FOR APPEAL UNDER 37 CFR 41.37 IN
U.S. PATENT APPLICATION NO. 09/691,334

Mail Stop Appeal Brief – Patents
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This Brief is submitted on appeal under 35 U.S.C. § 134 from the Final Rejection in the Office Action dated November 18, 2009 of claims 1-2, 7-8, 13-15, and 20-24 of U.S. Patent Application No. 09/691,334.

A Notice of Appeal was filed on February 17, 2010, and this Brief is timely filed by the deadline of April 17, 2010 (within two months of the filing of the Notice of Appeal).

REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of record Koninklijke Philips Electronics N.V., a corporation of the Netherlands having an office and a place of business at Groenewoudseweg 1, Eindhoven, Netherlands 5621 BA.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to applicant, applicant's legal representative, or the assignee, that will directly affect, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 1-24 are pending in the present application.

In the November 18, 2009 Final Office Action, pending claims 1-2, 7-8, 13-15, and 20-24 were finally rejected under 35 U.S.C. § 103(a). Dependent claims 3-6, 9-12, and 16-19 were objected to as being dependent upon rejected base claims¹, but such claims were indicated by the Examiner to be allowable if rewritten in independent form including all of

¹ Note that the January 29, 2010 Advisory Action indicated claims 3, 15, and 24 are objected to (e.g., as being dependent upon a rejected base claim), in contrast to the November 18, 2009 Final Office Action, which indicates that claims 3-6, 9-12, and 16-19 are objected to as being dependent upon a rejected base claim. *See* November 18, 2009 Final Office Action, pg. 8, ll. 10-13, and January 29, 2010 Advisory Action, pg. 1.

<u>Claim Status Summary in Final Office Action</u>	<u>Claim Status Summary in Advisory Action</u>
4) <input checked="" type="checkbox"/> Claim(s) <u>1-24</u> is/are pending in the application. 4a) Of the above claim(s) _____ is/are withdrawn 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. 6) <input checked="" type="checkbox"/> Claim(s) <u>1-2, 7-8, 13-15, 20-24</u> is/are rejected. 7) <input type="checkbox"/> Claim(s) <u>3-6, 9-12 and 16-19</u> is/are objected to.	The status of the claim(s) is (or will be) as follows: Claim(s) allowed: <u>none</u> . Claim(s) objected to: <u>3, 15 and 24</u> . Claim(s) rejected: <u>1, 2, 4-14 and 16-23</u> . Claim(s) withdrawn from consideration: <u>none</u> .

Applicant assumes that the objected-to status of claims 3-6, 9-12, and 16-19 contained in the November 18, 2009 Final Office Action is correct, and that the same status *should have been* acknowledged by the examiner in the January 29, 2010 Advisory Action, since the Advisory Action articulated no grounds for rejection of claims 3-6, 9-12, or 16-19 or any reasoning supporting rejection of such claims. It is therefore assumed that the claim status summary in the January 29, 2010 Advisory Action is erroneous and should be disregarded.

the limitations of the base claim and any intervening claims. Rejected claims 1-2, 7-8, 13-15, and 20-24 are the subject of this appeal.

A copy of the pending claims, including the claims involved in the present appeal, is provided in the enclosed Claims Appendix.

STATUS OF AMENDMENTS

Applicant filed a Response to the November 18, 2009 Final Office Action on January 18, 2010 that included amendments to independent claims 1 and 7. The claim amendments were considered and entered by the Examiner as indicated in the Advisory Action mailed on January 29, 2010. A copy of the appealed claims as amended on January 18, 2010 is contained in the enclosed Claims Appendix.

SUMMARY OF CLAIMED SUBJECT MATTER²

The independent claims pending in the present application are claims 1, 7, 13 and 20. Pending claims 2-6, 8-12, 14-19, and 21-24 are dependent claims. Rejected claims 1-2, 7-8, 13-15, and 20-24 are the subject of this appeal.

Independent claim 1 and dependent claim 2 are directed to a digital audio playback device (DAPD) including an external interface³ included within the digital audio playback device⁴ and coupled to a connected processing system⁵, said connected processing system executing a user interface application program⁶ that accesses and controls said digital audio playback device via said external interface⁷; a memory⁸ included within the digital audio

² It is respectfully noted appellants do not intend for the claimed subject matter to be limited to operation within the exemplary embodiments described in this brief, beyond what is required by the claim language. These examples and their description are provided to facilitate ease of understanding and to comply with the requirements of an appeal brief, without intending for any further interpreted limitations to be read into the claims as presented.

³ E.g., specification, ll. 14, page 6, ll. 1-5, page 13, and originally filed claim 1.

⁴ E.g., specification, ll. 13-18, page 6, and ll. 1-15, page 13.

⁵ E.g., specification, ll. 14-15, page 6, ll. 1-15, page 13, and originally filed claim 1.

⁶ E.g., specification, ll. 15-18, page 6, ll. 21-23, page 12, and originally filed claim 1.

⁷ E.g., specification, ll. 15-18, page 6, ln. 21, page 12 - ln. 5, page 13, and originally filed claim 1.

⁸ E.g., specification, ln. 18, page 6, ln. 12, page 14 - ln. 3, pg. 15, ll. 18-20, page 19, and originally filed claim 1.

playback device⁹ and coupled to said external interface¹⁰, wherein said memory stores a reverse DAPD application programming interface (API)¹¹; and a processor¹² coupled to said memory and said external interface¹³ that executes said reverse DAPD API¹⁴, said reverse DAPD API causes said processor to access and control a user interface¹⁵ associated with said user interface application program¹⁶, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said connected processing system¹⁷.

Independent claim 7 and dependent claim 8 are directed to a processing system¹⁸ including an external interface¹⁹ included within²⁰ and coupled to a connected digital audio playback device²¹, said connected digital audio playback device plays audio files stored in said digital audio playback device²²; a memory²³ included within the digital audio playback device²⁴ and coupled to said external interface²⁵, wherein said memory stores a user interface application program²⁶ that accesses and controls said digital audio playback device²⁷ via said external interface²⁸ and that stores a reverse DAPD application programming interface (API)²⁹; and a processor³⁰ coupled to said memory³¹ and said external interface³² that executes said user interface application program³³ and said reverse

⁹ E.g., specification, ll. 18-20, page 6, ll. 12-19, page 19.

¹⁰ E.g., specification, ll. 18-20, page 6, ll. 12-21, page 19, and originally filed claim 1.

¹¹ E.g., specification, ll. 18-20, page 6, ln. 12, page 19 – ln. 2, page 20, and originally filed claim 1.

¹² E.g., specification, ln. 20, page 6, ll. 16 – 17, page 19, and originally filed claim 1.

¹³ E.g., specification, ll. 21- 22, page 6, ll. 16-21, page 19, and originally filed claim 1.

¹⁴ E.g., specification, ll. 21- 22, page 6, ll. 9-15, page 20, and originally filed claim 1.

¹⁵ E.g., specification, ll. 20- 23, page 6, ll. 12-15, page 20, and originally filed claim 1.

¹⁶ E.g., specification, ln. 20, page 6 – ln. 3, page 7, ll. 12-15, page 20, and originally filed claim 1.

¹⁷ E.g., specification, ln. 20, page 6 – ln. 3, page 7, ll. 12-21, page 20, and originally filed claim 1.

¹⁸ E.g., specification, ln. 6, page 8, ll. 16-17, page 19, and originally filed claim 7.

¹⁹ E.g., specification, ll. 5-7, page 8, ll. 12-19, page 19, and originally filed claim 7.

²⁰ E.g., specification, ll. 4-7, page 8, ll. 12-19, page 19, and originally filed claim 7.

²¹ E.g., specification, ll. 4-7, page 8, ll. 12-21, page 19, and originally filed claim 7.

²² E.g., specification, ll. 8-9, page 8, ll. 3-5, page 20, and originally filed claim 7.

²³ E.g., specification, ll. 9-10, page 8, ll. 18-19, page 19, and originally filed claim 7.

²⁴ E.g., specification, ll. 9-10, page 8, ll. 16-19, page 19, and originally filed claim 7.

²⁵ E.g., specification, ll. 9-10, page 8, ll. 19-21, page 19, and originally filed claim 7.

²⁶ E.g., specification, ll. 9-10, page 8, ln. 21, page 19 - ln. 1, page 20, and originally filed claim 7.

²⁷ E.g., specification, ll. 10-12, page 8, ln. 21, page 19 – ln. 15, page 20, originally filed claim 7 and FIG. 3.

²⁸ E.g., specification, ll. 9-14, page 8, ln. 21, page 19 – ln. 15, page 20, originally filed claim 7, and FIG. 3.

²⁹ E.g., specification, ll. 9-14, page 8, ln. 21, page 19 – ln. 15, page 20, originally filed claim 7, and FIG. 3.

³⁰ E.g., specification, ln. 14, page 8, ll. 19-21, page 19, originally filed claim 7 and FIG. 3.

³¹ E.g., specification, ln. 14, page 8, ll. 19-21, page 19, originally filed claim 7 and FIG. 3.

³² E.g., specification, ll. 14-15, page 8, ll. 19-21, page 19, originally filed claim 7 and FIG. 3.

DAPD API³⁴, said reverse DAPD API communicates with said digital audio playback device³⁵ and enables said digital audio playback device to access and control a user interface associated with said user interface application program³⁶, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said processing system³⁷.

Independent claim 13 and dependent claims 14-15 are directed to a method of displaying information on a monitor screen³⁸, said method for use in association with a digital audio playback device (DAPD) and a connected processing system connected to the digital audio playback device³⁹, the method comprising the steps of: executing via a first processor⁴⁰ in the connected processing system⁴¹ a user interface application program⁴² that accesses and controls the digital audio playback device⁴³; and executing via a second processor⁴⁴ a reverse DAPD application programming interface (API) in the digital audio playback device⁴⁵, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program⁴⁶, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system⁴⁷.

Independent claim 20 and dependent claims 21-24 are directed to computer-executable instructions⁴⁸ comprising a method of displaying information on a monitor

³³ E.g., specification, ll. 14-16, page 8, ll. 3-15, page 20, originally filed claim 7 and FIG. 3.

³⁴ E.g., specification, ll. 14-16, page 8, ll. 9-15, page 20, originally filed claim 7 and FIG. 3.

³⁵ E.g., specification, ll. 16-20, page 8, ll. 12-15, page 20, originally filed claim 7 and FIG. 3.

³⁶ E.g., specification, ll. 16-21, page 8, ll. 12-15, page 20, ll. 5-11, pg. 21, originally filed claim 7 and FIG. 3.

³⁷ E.g., specification, ll. 16-21, page 8, ll. 12-21, page 20, ll. 5-19, pg. 21, originally filed claim 7 and FIG. 3.

³⁸ E.g., specification, ll. 16-19, page 13, and originally filed claim 13.

³⁹ E.g., specification, ln. 19, page 12 – ln. 19, page 13, and originally filed claim 13.

⁴⁰ E.g., specification, ln. 22, page 17 – ln. 4. page 18, and FIG. 2.

⁴¹ E.g., specification, ll. 16-18, page 13, ln. 22, page 17 – ln. 4. page 18, and FIG. 2.

⁴² E.g., specification, ll. 16-18, page 13, ln. 22, page 17 – ln. 4. page 18, and FIG. 2.

⁴³ E.g., specification, ll. 16-18, page 13, ln. 22, page 17 – ln. 11. page 18, and FIG. 2.

⁴⁴ E.g., specification, ll. 12-19, page 19, and FIG. 3.

⁴⁵ E.g., specification, ln. 12, page 19 – ln. 2, page 20, and FIG. 3.

⁴⁶ E.g., specification, ln. 12, page 19 – ln. 2, page 20, ll. 9-15, page 20, and FIG. 3.

⁴⁷ E.g., specification, ll. 16-19, page 13, FIG. 3 and FIG. 4.

⁴⁸ E.g., specification, ll. 15-21, page 14, and originally filed claim 20.

screen⁴⁹, said method for use in association with a digital audio playback device (DAPD) and a processing system connected to the digital audio playback device⁵⁰, said computer-executable instructions stored on a removable storage medium readable by said connected processing system⁵¹, the method comprising the steps of: executing via a first processor in the connected processing system a user interface application program that accesses and controls the digital audio playback device⁵²; and executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device⁵³, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program⁵⁴, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system⁵⁵.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-2, 7-8, 13-14, and 20-21 are unpatentable for obviousness under 35 U.S.C. § 103(a) over allegedly Admitted Prior Art (hereinafter “APA”) in view of U.S. Patent No. 7,237,198 to Chaney et al. (hereinafter “Chaney”)⁵⁶.

Whether claim 15 are unpatentable for obviousness under 35 U.S.C. § 103(a) over APA in view of Chaney, and further in view of U.S. Patent No. 5,991,520 to Smyers et al. (hereinafter “Smyers”)⁵⁷.

Whether claim 22 are unpatentable for obviousness under 35 U.S.C. § 103(a) over APA in view of Chaney, and further in view of U.S. Patent No. 6,762,798 to Messer et al. (hereinafter “Messer”)⁵⁸.

Whether claims 23-24 are unpatentable for obviousness under 35 U.S.C. § 103(a) over APA in view of Chaney, in view of Messer, and further in view of Smyers⁵⁹.

⁴⁹ E.g., specification, ll. 16-19, page 13, and originally filed claim 20.

⁵⁰ E.g., specification, ln. 16, page 13 – ln. 11, page 14, and originally filed claim 20

⁵¹ E.g., specification, ln. 16, page 13 – ln. 3, page 15, and originally filed claim 20

⁵² E.g., specification, ln. 22, page 17 – ln. 3, page 19, and FIG. 2.

⁵³ E.g., specification, ln. 12, page 19 – ln. 15, page 20, and FIG. 3.

⁵⁴ E.g., specification, ll. 12-15, page 20, and FIG. 3.

⁵⁵ E.g., specification, ll. 12-15, page 20, ll. 3-11, page 21, and FIG. 3.

⁵⁶ See 11/18/09 Final Office Action, pp. 2-5.

⁵⁷ See 11/18/09 Final Office Action, pp. 5-6.

⁵⁸ See 11/18/09 Final Office Action, pp. 6-7.

Each of the foregoing rejections is appealed by Applicant.

ARGUMENT

L. INTRODUCTION TO THE INVENTION

Digital audio playback devices are popular consumer products. The term digital audio playback device or “DAPD” is generally applied to a device that is capable of storage and playback of audio files in an electronic format. Popular forms of DAPDs include a diverse number of audio and music players on the market, nearly all of which are used in conjunction with another device – usually a personal computer – to facilitate transfer of digital music or audio files to be stored and played by the DAPD. A DAPD is usually attached to the other device via a cable or similar connector, but could communicate wirelessly. The other device (e.g., a personal computer) may be referred to herein as a “connected device.” Upon disconnection from the connected device, a DAPD embodies a portable and convenient platform for storage and playback of media content.

Typically, a DAPD includes a storage medium for digital audio files as well as processing capability and a user interface to interact and control playback of stored digital audio files. Most DAPDs include a built-in user interface (e.g., buttons or a scroll wheel or touch screen capability) and a display (e.g. a LCD or other type of display screen) to enable a user to control playback of the digital files that are stored on the DAPD. In addition to a built-in user interface, manipulation of the digital audio files and control of the DAPD may also be accomplished through a user interface on the connected device. A user interface associated with a connected device (e.g., a personal computer) may use a combination of existing external computer peripherals (i.e. mouse, keyboard, monitor, etc.) and software (i.e. applications, a user interface program, operating system of computer, etc.) installed on the connected device to control the DAPD. As DAPDs have become smaller, with less physical area for both external controls and a display, use of an interface on a connected device to control and manipulate the files stored on the DAPD has become more common. Many personal computers now include user interface software applications bundled with

⁵⁹ See 11/18/09 Final Office Action, pp. 7-8.

pre-installed media software. Additionally, user interface application programs for use on connected devices have been developed to provide additional features and capabilities for managing and manipulating audio files on a DAPD.

One obstacle in the development of DAPDs and associated user interface application programs by different parties (i.e. the DAPD manufacturer, the connected device manufacturer, or a third party software developer) is incompatibility between the connected device user application interface and a DAPD. In order for a user interface application program resident on the connected device to control a DAPD, device driver software must be provided (e.g., by the DAPD manufacturer) to establish communication between the DAPD and the connected device, and to allow control of a DAPD device by the operating system of the connected device. User interface application programs on the connected device must also be compatible with both the software and hardware of the connected device and the DAPD to enable manipulation of audio files on the DAPD.

A conventional method to overcome these obstacles is to provide DAPD device driver software for Internet download from the website of a DAPD manufacturer (e.g., from a software library including drivers for several DAPDs). Alternatively, device driver software may be stored on a storage medium (e.g., a CD) packaged with a DAPD at the point of sale. Such software may include application programming interfaces (APIs) that are compatible with one or more DAPDs. An API is a type of interface program that is necessary for user interface application programs on the connected device to access lower level software functions, thus enabling the interface application control program to control the DAPD. An API will usually work with several DAPDs, and DAPD manufacturers commonly configure DAPDs to be compatible with various APIs.

One effect of the above method is that software developers and sellers of connected device user interface software are able to establish relationships with consumers through features offered on proprietary connected device user interface software, and are further able to work with advertisers and audio content providers to control (1) what is displayed by the user interface application on the connected device, and (2) what websites are accessed through the user interface application software. Unfortunately (from the perspective of a DAPD manufacturer), a conventional technique employing an API resident on a connected device to control the DAPD allows the seller of the connected device user interface software

to control advertising displayed through the user interface software and also to control access to the DAPD for download of digital audio files from websites for use on the DAPD. According to such technique, the manufacturer of the DAPD device loses any ability to control access to content, and has no control of what is being displayed on-screen in association with the DAPD as audio files are manipulated.

To overcome the deficiencies associated with the conventionally employed techniques as described above, Applicant has recognized the desirability of providing an API that resides on the DAPD (i.e., a reverse DAPD API) and that allows DAPD manufacturers to use and control the user interface application software operating on a connected processing system through an API on the DAPD. Applicant has further recognized the desirability of providing DAPD manufacturers with control of user interface software operating on a connected processing system, in order to control the display of the user interface on a monitor screen associated with the connected processing system. In recognition of the foregoing, Applicant has disclosed “a reverse DAPD API ... used by a digital audio playback device to request that the user interface application program display some information on screen, such as the logo of the DAPD manufacturer, or allow the user to access a DAPD-specific web site, or the like⁶⁰. ”

As noted previously, independent claim 1 and dependent claim 2 are directed to a digital audio playback device (DAPD) including an external interface within the DAPD and coupled to a connected processing system, said connected processing system executing a user interface application program that accesses and controls the DAPD via the external interface; a memory included within the digital audio playback device and coupled to said external interface, wherein said memory stores a reverse DAPD application programming interface (API); and a processor coupled to said memory and said external interface that executes said reverse DAPD API, said reverse DAPD API causes said processor to access and control a user interface associated with said user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said connected processing system.

Independent claim 7 and dependent claim 8 are directed to a processing system that includes an external interface included within and coupled to a connected DAPD, said

⁶⁰ Specification, page 15, ll. 15-19.

connected DAPD playing audio files stored in said DAPD; a memory included within the DAPD and coupled to said external interface, wherein said memory stores a user interface application program that accesses and controls said digital audio playback device via said external interface and that stores a reverse DAPD application programming interface (API); and a processor coupled to said memory and said external interface that executes said user interface application program and said reverse DAPD API, said reverse DAPD API communicates with said DAPD and enables the DAPD to access and control a user interface associated with said user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said processing system.

Independent claim 13 and dependent claims 14-15 are directed to a method of displaying information on a monitor screen, the method for use in association with a DAPD and a connected processing system connected to the DAPD, the method including the steps of: executing via a first processor in the connected processing system a user interface application program that accesses and controls the DAPD; and executing via a second processor a reverse DAPD application programming interface (API) in the DAPD, wherein the step of executing the reverse DAPD API enables the DAPD to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system.

Independent claim 20, and dependent claims 21-24 are directed to computer-executable instructions that include a method of displaying information on a monitor screen, the method for use in association with a DAPD and a processing system connected to the DAPD, wherein the computer-executable instructions are stored on a removable storage medium readable by the connected processing system, the method including the steps of: executing via a first processor in the connected processing system a user interface application program that accesses and controls the digital audio playback device; and executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said

user interface application program is displayed on a monitor screen associated with the connected processing system.

II. LAW REGARDING OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. 103

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03.

In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), the Supreme Court stated that:

“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. ... [Rather], it can be **important to identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the [prior art] elements in the manner claimed.**⁶¹”

It is fundamental to a proper rejection of claims under 35 U.S.C. § 103 that an examiner must present a convincing line of reasoning supporting the rejection⁶². The Supreme Court in *KSR* affirmed the validity of such approach, stating that “**there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness**⁶³.”

III. DISCUSSION OF THE CITED ART AND MISINTERPRETATION BY THE EXAMINER OF THE CITED ART RELATIVE TO APPLICANT'S CLAIMS

A. The Examiner Has Misinterpreted Background Statements Made by Applicant Relating to Alleged “Admitted Prior Art”

In the November 18, 2009 Office Action, the examiner alleged that the background portion of the present application constitutes “Admitted Prior Art” that discloses “a DAPD⁶⁴ ..., a connected processing system ... , the external interface (playback device ...), a user

⁶¹ See *KSR*, 82 USPQ2d at 1389 (emphasis added).

⁶² See MPEP 2144 (“Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

⁶³ See *KSR*, 82 USPQ2d at 1396 (emphasis added).

⁶⁴ DAPD refers to digital audio playback device.

interface application program (a UI software application ...), a memory ..., storing ..., a DAPD application programming interface (API) (the libraries ... contain implementations of application programming interfaces) ..."⁶⁵.

To the extent that the examiner is characterizing background statements made by Applicant as suggesting that a DAPD includes a memory storing an application programming interface (API), **Applicant disputes and disagrees with such characterization.** While conventional DAPDs include memory (as necessary to store digital audio files), nothing in the background portion of the present application constitutes any admission that memory of conventional DAPDs contains any API.

Citations by the examiner to the background of the present application supporting the alleged "Admitted Prior Art," together with context and discussion relating to same, are summarized in the following table.

⁶⁵ November 18, 2009 Office Action, page 2.

<i>Alleged Disclosure of APA and Passage Cited by Examiner</i>	<i>Actual Disclosure Embodied in Passage Cited by Examiner</i>	<i>Comments on Disparity Between Alleged Disclosure and Actual Disclosure</i>
“a memory (memory, page 1, ln. 15-18) ⁶⁶ ”	“Typically, a digital audio playback device contains a large non-volatile memory, such as a flash random access memory (RAM) , that stores , for example, 64 megabytes (MB) of audio files .”	The bolded portions of the excerpted text (at right) indicate that the DAPD memory is used to store <u>audio files</u> .
“...storing (download, page 4, ln. 1-7) ⁶⁷ ”	Typically, the connected user interface executed by the PC may control a digital audio playback device via some software libraries made available by the manufacturer of the digital audio playback device and resident on the connected device. In many cases, a digital audio playback device user can download the user interface software libraries from the Internet. These libraries typically consist of the device drivers needed to communicate with and [to] control the digital audio playback device over the PC connection ⁶⁸ .”	The bolded portions of the excerpted text (at right) clarify that the user interface software is executed by the PC and suggests that it is downloaded to the PC (or “connected device”). Page 2, lines 1-3; page 3, lines 14-16; page 13, lines 15-21; and page 20, lines 5-8 of the specification indicate that a PC is needed to download audio/music files. Nothing in the specification discloses or suggests that a DAPD is used for downloading. Accordingly, the term “download” at page 4, line 4 (referenced by the examiner) does <u>not</u> refer to storing of any file (let alone an API) to a DAPD.
“...a X DAPD application programming interface (API) (the libraries ... contain implementations of application programming interfaces (API), page 4, ln. 1-15) ⁶⁹ ”	“These libraries also contain implementations of application programming interfaces (APIs) that are supported by the digital audio playback device. An API is the interface through which a software program accesses lower level software functions, such as an operating system.”	The text in the specification immediately preceding the excerpted text (at right) states that “[t]hese libraries typically consist of the device drivers needed to communicate with and [to] control the digital audio playback device over the PC connection ⁷⁰ . As noted above, these libraries are <u>downloaded to a PC</u> , not to a DAPD.

⁶⁶ November 18, 2009 Office Action, page 2.

⁶⁷ Id.

⁶⁸ Specification, page 3, ln. 22 – page 4, ln. 7.

⁶⁹ Id.

⁷⁰ Specification, page 4, ll. 5-7.

It appears that the examiner has confused various elements of a **DAPD** with a **connected device** (for example a PC) which may be used to control the DAPD. In order to dispel such confusion, portions of the background statements made by applicant are highlighted below.

The background section of the present application states:

“A pocket-sized digital audio playback device may have only three or four control buttons and a tiny LCD for displaying alphanumeric data. Hence, digital audio playback devices controlled by a user interface on a connected device are becoming increasingly common.”⁷¹

The foregoing text makes it clear that the connected device (i.e., a PC) is separate and distinct from the DAPD and that the DAPD does not comprise a connected device.

The background section of the present application further states:

“Typically, the connected user interface executed by the PC may control a digital audio playback device via some software libraries made available by the manufacturer of the digital audio playback device and resident on the connected device.”⁷²

The foregoing text makes it clear that the software libraries used to control a DAPD are typically resident on the connected device (i.e., PC) and not on the DAPD.

The background section of the present application further states:

“These libraries also contain implementations of application programming interfaces (APIs) that are supported by the digital audio playback device.”⁷³

The foregoing text makes it clear that the API is contained in the software libraries on the connected device, and not on the DAPD. Thus, the background section of the present application states that the connected device is separate and distinct from the DAPD, and that

⁷¹ Application, page 2, line 20 - page 3 line 1.

⁷² Application, page 3, line 22 - page 4 line 3.

⁷³ Application, page 4, line 8-10.

the software libraries, which contain APIs, are resident on the connected device -- not on the DAPD.

To further elucidate the differences between a conventional DAPD and a conventional connected device, characteristics of a conventional DAPD are contrasted with characteristics of a conventional connected device in the following table.

Characteristic	Conventional “DAPD”	Conventional “Connected Device”
Embodiment	May be embodied in a portable MP3 player ⁷⁴	May be embodied in a personal computer (PC)
User Interface control capability	On –board UI controlling only one attached DAPD ⁷⁵	Connected UI capable of controlling multiple external DAPDs from different manufacturers ⁷⁶ through a user interface application stored on the connected device ⁷⁷
Use of resident memory	Storage of audio files ⁷⁸	Storage of software libraries (e.g., device drivers and APIs to communicate with and control one or more external conventional DAPD ⁷⁹)
Method of control	Built-in UI ⁸⁰ with “only three or four control buttons” ⁸¹	Mouse attached to connected PC ⁸²
Display	“tiny LCD” ⁸³	Display may include a “monitor screen” ⁸⁴

⁷⁴ Application, page 1, line 18 – page 2, line 1.

⁷⁵ Application, page 2, lines 6-9.

⁷⁶ Application, page 4, lines 18-19.

⁷⁷ Application, page 3, line 22 – page 4, line 3.

⁷⁸ Application, page 1, lines 15-18.

⁷⁹ Application, page 3, line 22 – page 4, line 10.

⁸⁰ Application, page 2, lines 11-12.

⁸¹ Application, page 2, lines 20-22.

⁸² Application, page 3, lines 10-11.

⁸³ Application, page 2, lines 20-22.

⁸⁴ Application, page 3, lines 5-7.

As can be seen by contrasting these characteristics in the foregoing table, a conventional DAPD has a built in UI (user interface) capable of controlling only itself and the memory resident in a conventional DAPD is used only for storage of audio files. In contrast, a conventional connected device may control multiple external DAPDs, and the memory resident in a connected device may store software libraries, drivers, and APIs.

Thus, as demonstrated in the discussion and foregoing table, a conventional DAPD is distinct from a conventional connected device in multiple aspects. Even though both a conventional DAPD (i.e., with controls local to the DAPD) and a conventional connected device (i.e., with software/drivers, including APIs) may be used to control aspects of a DAPD, the software libraries and APIs used by a conventional connected device to control a conventional DAPD reside solely on the conventional connected device. In summary, the background section of the present application (alleged “Admitted Prior Art” or “APA”) **does not disclose an API stored in the memory of a conventional DAPD.**

At page 3 of the November 18, 2009 Office Action, the examiner conceded that “APA [Admitted Prior Art] does not teach reverse the memory stores DAPI API (*sic*, DAPD API) capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system.” Applicant agrees that the background section of the present application does not disclose a DAPD with memory storing an API, as apparently conceded by the examiner in such passage.

B. The Examiner Has Misinterpreted the Disclosure of Chaney Relative to Applicant’s Claims

In the November 18, 2009 Office Action at page 3 thereof, the examiner alleged

“...Chaney teaches reverse DAPI API (*sic*, DAPD API)⁸⁵ capable of external interface causing a processor to access and control a user interface

⁸⁵ Applicant notes that the examiner has utilized inconsistent terminology in the November 18, 2009 Office Action and the January 29, 2010 Advisory Action. While Applicant’s claims including only the acronym-containing terms “DAPD” and “reverse DAPD API,” the examiner has made various references to a “DAPI API” (e.g., Office Action, page 3) and “reverse DAPD” (e.g., Office Action, pages 5-6). Applicant assumes in each instance that the examiner meant to refer to “reverse DAPD API.” The examiner further referred to the term “DIAPI” (e.g., Office Action page 4 and Advisory Action, page 2), which is described by Chaney as a

and displayed on a monitor screen associated with said connected processing system, displayed on a monitor screen associated with said connected processing system.”

Pages 3-4 of the November 18, 2009 Office Action contain a lengthy discussion of Chaney without specifically identifying disclosure in Chaney of any reverse DAPD API stored in memory of a DAPD or executed by a DAPD.

To the contrary, page 3, lines 11-12 of the Office Action state that Chaney’s “client computer 104 comprises ... an electronic music player 144 [and] a music renderer controller 148” and page 4, line 6 of the Office Action refers to “[t]he DIAPI of the music renderer controller.” In the January 29, 2010 Advisory Action at page 2 (responding to point (2) therein), the examiner similarly referred to “the DIAPI of the music renderer controller 148.” The foregoing statements in combination therefore logically refer to a DIAPI as associated with the music renderer controller of the client computer.

As indicated in the background section of the present application, an API stored on a client computer for controlling a DAPD is well known in the art. The examiner has apparently failed to recognize that a “reverse DAPD API” within the scope of Applicant’s claims is contained in (or executed by) the DAPD (digital audio playback device), NOT a connected processing system (e.g., personal computer) having an associated monitor screen. This critical point eliminates the relevance of Chaney (and the alleged Admitted Prior Art) to Applicant’s independent claims.

The examiner’s mention of Chaney disclosure that each music renderer 126A-126N may include a microprocessor⁸⁶ is irrelevant to the issue whether the music renderers 126A-126N have stored in memory therein a reverse DAPD API or are arranged to execute a reverse DAPD API. Chaney discloses a DIAPI stored in and solely executed by the client computer 104. Such client computer according to Chaney is analogous in character to the “connected processing system” as containing a “monitor screen” recited in Applicant’s independent claims 1, 7, 13, and 20. Despite the possible presence of a microprocessor in each component, the “connected processing system” and “digital audio playback device”

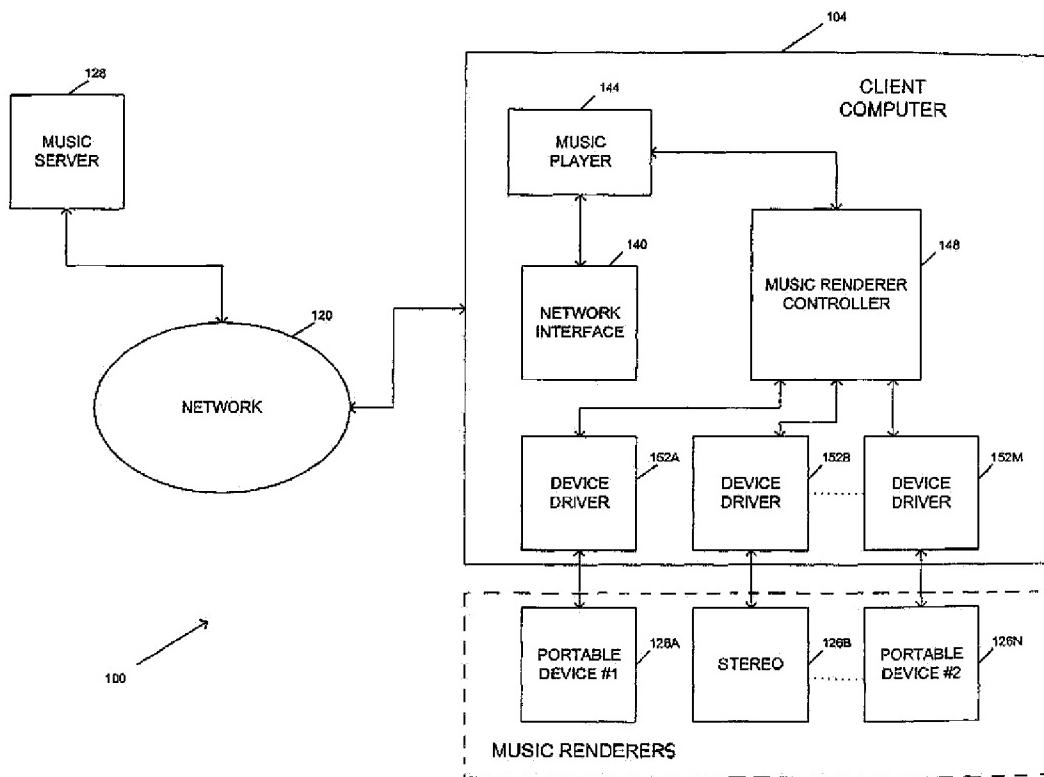
⁸⁶ “device integration application program interface” as part of the music renderer controller 148 of the client computer (Chaney, col. 4, lines 5-10).

⁸⁶ E.g., November 18, 2009 Office Action, page 9 and January 29, 2010 Advisory Action, page 2, with reference to Chaney col. 3, lines 38-45.

recited in Applicant's claims are not synonymous with or interchangeable with one another, for at least the reason that the claimed "connected processing system" requires an associated monitor screen. The examiner appears to have ignored this distinction.

Applicant's detailed discussion of Chaney's disclosure is provided below.

Chaney discloses a music player 144⁸⁷ that operates (e.g., as a software program⁸⁸) on a client computer 104, and that is arranged to communicate with multiple music renderers 126A-126N (e.g., conventional portable digital audio players, analogous to conventional DAPDs disclosed in the background of the present application). A music renderer controller 148 and device drivers 152A-152M that reside in the client computer 104 enable communication between the client computer 104 and the music renderers 126A-126N. The client computer 104 further includes a network interface 140 that enables communication with an external music server 128 via a communication network 120. Figure 1 of Chaney showing the foregoing features is reproduced below for ease of reference.



⁸⁷ It is noted that U.S. Patent No. 7,237,198 is assigned to RealNetworks, Inc., and the "music player 144" appears to correspond in character to the "RealPlayer" application that is widely distributed by RealNetworks, Inc.

⁸⁸ See Chaney, col. 4, lines 58-65 and claim 5 ("wherein the music player is a program executing on a computer").

Chaney draws a clear distinction between a “client computer 104” and “music renderers 126A-126N.” As is clear from Chaney FIG. 1 and col. 3, lines 56-59 thereof, Chaney’s device drivers 152A-152M are contained in the client computer 104. Chaney’s device drivers 152A-152M include application program interfaces (APIs) enabling communication with Chaney’s music renderer controller 148.⁸⁹ Chaney states at page 6, lines 14-15 thereof that “[a] **device driver can provide controls for the music renderer,**” and that a device driver associated with the music player 148 (within Chaney’s client computer 104) can integrate any new control windows into the music renderer. Moreover, Chaney discloses that “each device driver can customize the control portion depending on the requirement of **the music renderer that is being managed by the device driver**⁹⁰.” The foregoing features are entirely consistent with Chaney’s **control of a music renderer (126A-126N) by the client computer 104.**

Chaney’s control of a music renderer by the client computer 104 is further emphasized by Chaney col. 10, lines 21-28, as reproduced below:

“[B]y using the DIAPI, changes in firmware of one of the music renderers 126A 126N do not necessitate changes in the electronic music player 144. If additional features are provided with respect to one the music renderers 126A 126N, a new device driver may be created to communicate with the music renderer controller 148 and thereby allow the user to take advantage of such new features without requiring a re-design of the music player.”

The foregoing excerpt makes clear that a new device driver may be created to enable communication with a music renderer after a firmware update of the music renderer. Nothing in the foregoing passage suggests transmission of any API from a music renderer to Chaney’s client computer 104.

This is further reiterated by the flowchart of Chaney FIG. 5 “illustrating a process of utilizing the music player of FIG. 1⁹¹. At col. 9, lines 41-62, Chaney describes the installation of a new music renderer at step 520. A summary of such installation is as follows:

⁸⁹ Chaney, col. 5, lines 41-44.

⁹⁰ Chaney, col. 8, lines 65-67.

⁹¹ Chaney, col. 3, lines 7-8.

1. “At step 520, the user can request to install a new music renderer.”⁹²
2. “...the user is provided a list of music renderers that are supported by the music player 144.”⁹³
3. “Upon the selection of a music renderer, the music player 144 identifies the location of a device driver for the selected music renderer. The location of the device driver for the selected music renderer can either be provided by the user or alternatively be maintained by the music server 128.”⁹⁴
4. “...if the device driver is not on the client computer 104, the client computer 104 requests another computer that is connected to the network 120 to transmits the device driver to the client computer 104.” or “the music player 144 requests the user to insert program storage device, such as a compact diskette, so that the music player 144 may copy the device driver to the client computer 104.”⁹⁵

The foregoing excerpts from Chaney make clear that a new music renderer is installed by copying the required device driver to client computer 104. Again, this is entirely consistent with Chaney’s control of a music renderer (126A-126N) by the client computer 104. Several locations are identified by Chaney as sources for the device driver; for example, such driver may be provided by the user, on client computer 104, on another computer connected to network 120, or on a storage device such as a compact disk. Again, this is entirely consistent with Chaney’s control of a music renderer (156A-126N) by client computer 104. Nothing in the foregoing passage – or indeed anywhere in Chaney’s disclosure – suggests storage of any device driver or API on a music renderer, or transmission of any device driver or API from a music renderer to Chaney’s client computer 104.

All of the control features disclosed by Chaney relate to a client computer controlling a music renderer – NOT a music renderer controlling a client computer. Furthermore, nothing in Chaney discloses or suggests storage of a control program (i.e. device driver or API) on a DAPD.

It is therefore clear that **Chaney fails to disclose a reverse DAPD application programming interface (API) stored on or executed by a DAPD**, such as may be used to

⁹² Chaney, col. 9, lines 43-44.

⁹³ Chaney, col. 9, lines 45-47.

⁹⁴ Chaney, col. 9, lines 50-54.

⁹⁵ Chaney, col. 9, lines 55-62..

cause a processor of the DAPD to access and control a user interface associated with a user interface application program executed on a connected processing system.

IV. NONE OF CLAIMS 1-2 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED “ADMITTED PRIOR ART” (“APA”) IN VIEW OF CHANEY

In the November 18, 2009 Office Action, claims 1-2 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over allegedly Admitted Prior Art (“APA”) in view of Chaney.

Applicant’s independent claim 1 and dependent claim 2 require (*inter alia*) “a memory included within the digital audio playback device and coupled to said external interface, wherein said memory stores a reverse DAPD application programming interface (API).”

At page 3 of the November 18, 2009 Office Action, the examiner conceded that “APA [Admitted Prior Art] does not teach reverse the memory stores DAPI API (*sic*, DAPD API) capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system,” but alleged that “Chaney teaches reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said central processing system.”

As noted previously, the November 18, 2009 Office Action fails to specifically identifying disclosure in Chaney of any reverse DAPD API stored in memory of a DAPD. The examiner has apparently failed to recognize that a “reverse DAPD API” within the scope of Applicant’s claim 1 is contained in the DAPD (digital audio playback device), NOT a connected processing system (e.g., personal computer) having an associated monitor screen.

For at least the reason that the art relied upon by the examiner fails to disclose “a memory included within the digital audio playback device and coupled to said external interface, wherein said memory stores a reverse DAPD application programming interface (API),” the art fails to disclose all limitations of claim 1, as would be required to establish a *prima facie* case of obviousness under 35 U.S.C. 103 (i.e., pursuant to MPEP §2143.03.).

Since claim 2 depends from claim 1 and inherently includes all the features of claim 1⁹⁶, dependent claim 2 is patentably distinguished over the cited art for at least the same reasons as claim 1. Accordingly, withdrawal of the rejections of claims 1 and 2 under 35 U.S.C. 103 is warranted, and is respectfully requested.

V. NONE OF CLAIMS 7-8 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED “ADMITTED PRIOR ART” (“APA”) IN VIEW OF CHANEY

In the November 18, 2009 Office Action, claims 7-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over allegedly Admitted Prior Art (“APA”) in view of Chaney.

Applicant’s independent claim 7 and dependent claim 8 require (*inter alia*) “a memory included within the digital audio playback device and coupled to said external interface, wherein said memory ... stores a reverse DAPD application programming interface (API).”

At page 3 of the November 18, 2009 Office Action, the examiner conceded that “APA [Admitted Prior Art] does not teach reverse the memory stores DAPI API (*sic*, DAPD API) capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system,” but alleged that “Chaney teaches reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said central processing system.”

As noted previously, the November 18, 2009 Office Action fails to specifically identifying disclosure in Chaney of any reverse DAPD API stored in memory of a DAPD. The examiner has apparently failed to recognize that a “reverse DAPD API” within the scope of Applicant’s claim 7 is contained in the DAPD (digital audio playback device), NOT a connected processing system (e.g., personal computer) having an associated monitor screen.

For at least the reason that the art relied upon by the examiner fails to disclose “a memory included within the digital audio playback device and coupled to said external

⁹⁶ See 35 U.S.C. 112, fourth paragraph.

interface, wherein said memory stores a reverse DAPD application programming interface (API)," the art fails to disclose all limitations of claim 7, as would be required to establish a *prima facie* case of obviousness under 35 U.S.C. 103 (i.e., pursuant to MPEP §2143.03.). Since claim 8 depends from claim 7 and inherently includes all the features of claim 7, dependent claim 8 is patentably distinguished over the cited art for at least the same reasons as claim 7. Accordingly, withdrawal of the rejections of claims 7 and 8 under 35 U.S.C. 103 is warranted, and is respectfully requested.

VI. NONE OF CLAIMS 13-14 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED "ADMITTED PRIOR ART" ("APA") IN VIEW OF CHANEY

In the November 18, 2009 Office Action, claims 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over allegedly Admitted Prior Art ("APA") in view of Chaney.

Applicant's independent claim 13 and dependent claim 14 require (*inter alia*) "executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system."

At page 3 of the November 18, 2009 Office Action, the examiner conceded that "APA [Admitted Prior Art] does not teach reverse the memory stores DAPI API (*sic*, DAPD API) capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said connected processing system," but alleged that "Chaney teaches reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said central processing system."

As noted previously, the November 18, 2009 Office Action fails to specifically identifying disclosure in Chaney of any reverse DAPD API executed by the DAPD. The examiner has apparently failed to recognize that a "reverse DAPD API" within the scope of

Applicant's claim 13 is executed by the DAPD (digital audio playback device), NOT a connected processing system (e.g., personal computer) having an associated monitor screen.

For at least the reason that the art relied upon by the examiner fails to disclose "executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system," the art fails to disclose all limitations of claim 13, as would be required to establish a *prima facie* case of obviousness under 35 U.S.C. 103 (i.e., pursuant to MPEP §2143.03.). Since claim 14 depends from claim 13 and inherently includes all the features of claim 13, dependent claim 14 is patentably distinguished over the cited art for at least the same reasons as claim 13. Accordingly, withdrawal of the rejections of claims 13 and 14 under 35 U.S.C. 103 is warranted, and is respectfully requested.

VII. NONE OF CLAIMS 20-21 ARE OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED "ADMITTED PRIOR ART" ("APA") IN VIEW OF CHANEY

In the November 18, 2009 Office Action, claims 20-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable for obviousness over allegedly Admitted Prior Art ("APA") in view of Chaney.

Applicant's independent claim 20 and dependent claim 21 require (*inter alia*) the method step of "executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system."

At page 3 of the November 18, 2009 Office Action, the examiner conceded that "APA [Admitted Prior Art] does not teach reverse the memory stores DAPI API (*sic*, DAPD API) capable of external interface causing a processor to access and control a user interface

and displayed on a monitor screen associated with said connected processing system,” but alleged that “Chaney teaches reverse DAPD API capable of external interface causing a processor to access and control a user interface and displayed on a monitor screen associated with said central processing system.”

As noted previously, the November 18, 2009 Office Action fails to specifically identifying disclosure in Chaney of any reverse DAPD API executed by the DAPD. The examiner has apparently failed to recognize that a “reverse DAPD API” within the scope of Applicant’s claim 20 is executed by the DAPD (digital audio playback device), NOT a connected processing system (e.g., personal computer) having an associated monitor screen.

For at least the reason that the art relied upon by the examiner fails to disclose “executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system,” the art fails to disclose all limitations of claim 20, as would be required to establish a *prima facie* case of obviousness under 35 U.S.C. 103 (i.e., pursuant to MPEP §2143.03.). Since claim 21 depends from claim 20 and inherently includes all the features of claim 20, dependent claim 21 is patentably distinguished over the cited art for at least the same reasons as claim 20. Accordingly, withdrawal of the rejections of claims 20-21 under 35 U.S.C. 103 is warranted, and is respectfully requested.

VIII. CLAIM 15 IS NOT OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED “ADMITTED PRIOR ART” (“APA”) IN VIEW OF CHANEY AND SMYERS

In the November 18, 2009 Office Action, claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over allegedly Admitted Prior Art in view of Chaney as applied to claim 1 above, and further in view of U.S. Patent 5,991,520 to Smyers (hereinafter, “Smyers”).

Claim 15 depends from independent claim 13, and therefore inherently includes all features of claim 13⁹⁷. Patentable distinctions of independent claim 13 over allegedly Admitted Prior Art in view of Chaney have been previously established herein. The addition of Smyers fails to remedy the deficiency of allegedly Admitted Prior Art and Chaney in disclosing all elements of claim 13. The rejection of claim 15 should be withdrawn for at least the same reasons as articulated above in connection with claim 13.

Moreover, at pages 5-6 of the November 18, 2009 Office Action, the examiner alleged:

“As to claim 15, APA and Chaney do not teach API comprises first data associated with a manufacturer of the digital audio playback device and wherein the step of executing the reverse DAPD includes using the first data to vary at least a portion of user interface. However, Smyers teaches API comprises first data associated with a manufacturer of the digital audio playback device and wherein the step of executing the reverse DAPD includes using the first data to vary at least a portion of user interface (col 4, ln 1-5/ln 37-41/ col 5, ln 33-42/ col 7, ln 45-50/ col 9, ln 2-13/ ln 20-27), API comprises first data associated with a manufacturer of said digital audio playback device (col 2, ln 20-30).”

Applicant disagrees with the examiner’s characterization of Smyers’ disclosure and the examiner’s resulting conclusion of obviousness.

The rejection of claim 15 should be withdrawn for at least the additional reasons that (1) Smyers fails to disclose any reverse DAPD API executed by a DAPD, and (2) Smyers fails to disclose API that comprises first data associated with a manufacturer of the digital audio playback device, as required by claim 15.

Applicant has reviewed the reference portions identified at pages 5-6 of the November 18, 2009 Office Action⁹⁸ where examiner alleged that Smyers discloses an API comprising first data associated with a manufacturer of the digital audio playback device. Following such review, Applicant finds no indication of the teaching alleged by the examiner, either in the reference portions specifically identified by the examiner or in the entire disclosure of Smyers.

⁹⁷ 35 U.S.C. 112, fourth paragraph.

⁹⁸ Specifically, “col 4, ln 1-5/ln 37-41/ col 5, ln 33-42/ col 7, ln 45-50/ col 9, ln 2-13/ ln 20-27 and col 2, ln 20-30” of Smyers, as identified by the examiner.

Since Smyers fails to disclose API comprises first data associated with a manufacturer of the digital audio playback device, no combination of Smyers with the allegedly APA and Chaney embodies all elements of Applicant's dependent claim 15. Accordingly, withdrawal of the rejection of dependent claims 15 is warranted, and is respectfully requested.

IX. CLAIM 22 IS NOT OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED “ADMITTED PRIOR ART” (“APA”) IN VIEW OF CHANEY AND MESSER

In the November 18, 2009 Office Action, claim 22 was rejected under 35 U.S.C. 103(a) as being unpatentable over allegedly Admitted Prior Art in view of Chaney as applied to claim 13 above, and further in view of U.S. Patent 6,762,798 to Messer et al. (hereinafter, "Messer").

Claim 22 depends from independent claim 20, and therefore inherently includes all features of claim 20⁹⁹. Patentable distinctions of independent claim 20 over allegedly Admitted Prior Art in view of Chaney have been previously established herein. Messer discloses methods and apparatuses for providing video control for television applications; Messer is not concerned with any reverse DAPD API. The addition of Messer fails to remedy the deficiency of allegedly Admitted Prior Art and Chaney in disclosing all elements of independent claim 20. The rejection of claim 22 should be withdrawn for at least the same reasons as articulated above in connection with claim 20. Since no combination of the cited art discloses all elements of Applicant's claim 22, withdrawal of the rejections of such claim is warranted, and is respectfully requested.

X. CLAIMS 23-24 ARE NOT OBVIOUS UNDER 35 U.S.C. 103 OVER ALLEGED “ADMITTED PRIOR ART” (“APA”) IN VIEW OF CHANEY, MESSER, AND SMYERS

In the November 18, 2009 Office Action, claims 23-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over allegedly Admitted Prior Art in view of Chaney as applied to claim 13 above, and further in view of Messer and Smyers.

⁹⁹ 35 U.S.C. 112, fourth paragraph.

Claims 23-24 depend (whether directly or indirectly) from independent claim 20, and therefore inherently includes all features of claim 20¹⁰⁰. Patentable distinctions of independent claim 20 over allegedly Admitted Prior Art in view of Chaney have been previously established herein. Smyers discloses an API for managing and automatic data transfer operations between applications over a bus structure; Smyers is not concerned with any reverse DAPD API. Messer discloses methods and apparatuses for providing video control for television applications; Messer is not concerned with any reverse DAPD API. The addition of Smyers and Messer fails to remedy the deficiency of allegedly Admitted Prior Art and Chaney in disclosing all elements of independent claim 20. The rejections of claims 23-24 should be withdrawn for at least the same reasons as articulated above in connection with claim 20. Since no combination of the cited art discloses all elements of Applicant's claims 23-24, withdrawal of the rejections of such claims is warranted, and is respectfully requested.

XI. THE EXAMINER HAS NOT PROVIDED ARTICULATED REASONING WITH RATIONAL UNDERPINNING TO SUPPORT LEGAL CONCLUSION OF OBVIOUSNESS WITH RESPECT TO CLAIM 22

It is fundamental to a proper rejection of claims under 35 U.S.C. § 103 that an examiner must present a convincing line of reasoning supporting the rejection¹⁰¹. The Supreme Court in *KSR* affirmed the validity of such approach, stating that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”¹⁰².

Following *KSR*, the Federal Circuit held that although “rigid” application of the “teaching, suggestion, or motivation” (“TSM”) test for obviousness is improper, **application of a flexible TSM test remains the primary guarantee against improper “hindsight” analysis**, because a flexibly applied TSM test ensures that the obviousness analysis proceeds on the basis of evidence in existence before time the application was filed, as required by 35 U.S.C. § 103¹⁰³.

¹⁰⁰ 35 U.S.C. 112, fourth paragraph.

¹⁰¹ See MPEP 2144 (“Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103”), citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985).

¹⁰² See *KSR*, 82 USPQ2d at 1396 (emphasis added).

¹⁰³ *Ortho-McNeil Pharm. Inc. v. Mylan Labs., Inc.*, 520 F3d 1358, 86 USPQ2d 1196, 1201-02 (Fed. Cir. 2008).

In the November 18, 2009 Office Action, the examiner proposed the following reason for combining the purported Admitted Prior Art, Chaney, and Messer to yield the subject matter of claim 22:

“It would have been obvious to one of ordinary skill at the time the invention was made to combine the teaching of APA, Chaney with Messer to incorporate the feature of API, which identifies a manufacturer of said digital audio playback device, and wherein said reverse API is capable of causing an identity of the manufacturer to be displayed because this enables a video window to be translated as well as scaled to accommodate a variety of televisions¹⁰⁴. ”

The foregoing proposed reason (i.e., “enabl[ing] a video window to be translated as well as scaled to accommodate a variety of televisions”) is not inherently tied to Applicant’s invention embodied in claim 22. For example, accuracy and timeliness of information and ease of use do not compel the element of “the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device” recited in claim 22. In this regard, the reasoning advanced by the examiner to support the proposed rejection of claim 22 is not rationally related to the claim, such that the examiner has failed to provide “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” as required by *KSR* to support an obviousness rejection of claim 22. It appears that the examiner has advanced arguments reliant upon “*ex post* reasoning” due to an improper hindsight bias based upon knowledge of Applicant’s disclosure; the Federal Circuit has cautioned against such methodology (following the Supreme Court’s *KSR* decision) in *Ortho-McNeil Pharm. Inc. v. Mylan Labs., Inc.*, *supra*. This provides an additional independent basis for withdrawal of the rejection of claim 22 under 35 U.S.C. 103. Withdrawal of such rejection is warranted, and is respectfully requested.

¹⁰⁴ November 18, 2009 Office Action, page 7.

CONCLUSION

For the reasons presented above, the rejections of claims under 35 U.S.C. § 103 should be reversed.

Respectfully submitted,

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Enclosures:

- **Claims Appendix**
- **Evidence Appendix**
- **Related Proceedings Appendix**

CLAIMS APPENDIX

1. (Previously presented) A digital audio playback device (DAPD) comprising:
an external interface included within the digital audio playback device and coupled to a connected processing system, said connected processing system executing a user interface application program that accesses and controls said digital audio playback device via said external interface;
a memory included within the digital audio playback device and coupled to said external interface, wherein said memory stores a reverse DAPD application programming interface (API); and
a processor coupled to said memory and said external interface that executes said reverse DAPD API, said reverse DAPD API causes said processor to access and control a user interface associated with said user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said connected processing system.
2. (Previously presented) The digital audio playback device as set forth in Claim 1 wherein said reverse DAPD API comprises executable instructions that communicates with and controls an operation of said user interface application program.
3. (Previously presented) The digital audio playback device as set forth in Claim 1 wherein said reverse DAPD API comprises first data which identifies a manufacturer of said digital audio playback device, and wherein said reverse DAPD API causes an identity of the manufacturer to be displayed on the monitor screen in a human-readable form.
4. (Previously presented) The digital audio playback device as set forth in Claim 1 wherein said reverse DAPD API comprises first data associated with a manufacturer of said digital audio playback device, and wherein said reverse DAPD API causes said processor to access and control at least a portion of said user interface to display said first data in said at least a portion of said user interface displayed on said monitor screen.

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5. (Original) The digital audio playback device as set forth in Claim 4 wherein said first data comprises a graphics file comprising a logo image associated with said manufacturer.
6. (Original) The digital audio playback device as set forth in Claim 4 wherein said first data comprises a Universal Resource Locator (URL) associated with an Internet web site associated with said manufacturer.
7. (Previously presented) A processing system comprising:
an external interface included within and coupled to a connected digital audio playback device, said connected digital audio playback device plays audio files stored in said digital audio playback device;
a memory included within the digital audio playback device and coupled to said external interface, wherein said memory stores a user interface application program that accesses and controls said digital audio playback device via said external interface and that stores a reverse DAPD application programming interface (API); and
a processor coupled to said memory and said external interface that executes said user interface application program and said reverse DAPD API, said reverse DAPD API communicates with said digital audio playback device and enables said digital audio playback device to access and control a user interface associated with said user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with said processing system.
8. (Previously presented) The processing system as set forth in Claim 7 wherein said reverse DAPD API comprises executable instructions that communicates with and controls an operation of said user interface application program.
9. (Previously presented) The processing system as set forth in Claim 7 wherein said reverse DAPD API comprises first data indicative of an identity of a manufacturer of said digital audio playback device, and wherein said reverse DAPD API causes an identity of said

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manufacturer to be displayed in said at least a portion of said user interface displayed in said monitor screen.

10. (Previously presented) The processing system as set forth in Claim 7 wherein said reverse DAPD API comprises first data associated with an identity of a manufacturer of said digital audio playback device, and wherein said reverse DAPD API enables said digital audio playback device to access and control at least a portion of said user interface to display said first data in said at least a portion of said user interface displayed on said monitor screen.

11. (Original) The processing system as set forth in Claim 10 wherein said first data comprises a graphics file comprising a logo image associated with said manufacturer.

12. (Original) The processing system as set forth in Claim 10 wherein said first data comprises a Universal Resource Locator (URL) associated with an Internet web site associated with said manufacturer.

13. (Previously presented) A method of displaying information on a monitor screen, said method for use in association with a digital audio playback device (DAPD) and a connected processing system connected to the digital audio playback device, the method comprising the steps of:

executing via a first processor in the connected processing system a user interface application program that accesses and controls the digital audio playback device; and

executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system.

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14. (Previously presented) The method as set forth in Claim 13 wherein the reverse DAPD API comprises executable instructions that communicates with and controls an operation of the user interface application program.
15. (Previously presented) The method as set forth in Claim 13 wherein the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device and wherein the step of executing the reverse DAPD includes using the first data to vary at least a portion of the user interface.
16. (Previously presented) The method as set forth in Claim 13 wherein the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device and wherein the step of executing the reverse DAPD API comprises the substep of accessing and controlling at least a portion of the user interface displayed on the monitor screen.
17. (Original) The method as set forth in Claim 16 wherein the step of executing the reverse DAPD API comprises the substep of displaying the first data in the at least a portion of the user interface.
18. (Original) The method as set forth in Claim 17 wherein the first data comprises a graphics file comprising a logo image associated with the manufacturer.
19. (Original) The method as set forth in Claim 17 wherein the first data comprises a Universal Resource Locator (URL) associated with an Internet web site associated with the manufacturer.
20. (Previously presented) Computer-executable instructions comprising a method of displaying information on a monitor screen, said method for use in association with a digital audio playback device (DAPD) and a processing system connected to the digital audio playback device, said computer-executable instructions stored on a removable storage medium readable by said connected processing system, the method comprising the steps of:

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executing via a first processor in the connected processing system a user interface application program that accesses and controls the digital audio playback device; and
executing via a second processor a reverse DAPD application programming interface (API) in the digital audio playback device, wherein the step of executing the reverse DAPD API enables the digital audio playback device to access and control a user interface associated with the user interface application program, wherein the user interface associated with said user interface application program is displayed on a monitor screen associated with the connected processing system.

21. (Previously presented) The computer-executable instructions stored on a removable storage medium as set forth in Claim 20 wherein the reverse DAPD API comprises executable instructions that communicates with and controls an operation of the user interface application program.

22. (Original) The computer-executable instructions stored on a removable storage medium as set forth in Claim 20 wherein the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device.

23. (Original) The computer-executable instructions stored on a removable storage medium as set forth in Claim 22 wherein the step of executing the reverse DAPD API comprises the substep of accessing and controlling at least a portion of the user interface displayed on the monitor screen.

24. (Original) The computer-executable instructions stored on a removable storage medium as set forth in Claim 23 wherein the step of executing the reverse DAPD API comprises the substep of displaying the first data in the at least a portion of the user interface.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132 in the application that is the subject of the present appeal, and appellant is not relying on any evidence by the examiner in the record. Accordingly, no evidence is identified in this Evidence Appendix.

RELATED PROCEEDINGS APPENDIX

There exist no other prior or pending appeals, interferences or judicial proceedings known to appellant, appellant's attorney, or the assignee that may be related to, direct affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. Accordingly, there exist no decisions rendered by a court or the Board in any related proceeding, such that no related proceedings are identified in this Related Proceedings Appendix.